

### III. REMARKS

Claims 1-4, 6-8 and 10-22 are pending in this application. By this amendment, claims 1, 6, 10, 11, 15, 18 and 22 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement as it relates to the “assessing the impacts of the solutions” step in the claims. In response, Applicant respectfully disagrees with the Office’s allegation and contends that various portions of the specification adequately enable one of ordinary skill in the art of organizational and operational performance to practice the invention. Applicant points, for example, to page 9, line 4 - page 10, line 6 as well as to page 13, lines 2-13 of the specification as adequate support for the “assessing the impacts of the solutions” portion of the claimed invention. These sections show, *inter alia*, the use of conflict resolution rules and standards 42 for assisting the assessing of impacts of the solutions. Accordingly, Applicant requests withdrawal of the rejection.

Further, claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as it relates to the use of the term “improving a business value” in the preambles of the claims. The Office requests clarification and states “[w]hile some operational metrics may affect a company’s business value, there are many other factors such as market stability, employment rate, etc. that will affect the business value of a

company.” Office Action, page 3, item 5. In response, Applicant has amended the claims in order to clarify the claimed invention. Further, while the Office states that some of the factors may affect business value that are other than operational metrics, Applicant respectfully responds that *assuming arguendo* that the Office is correct, the present invention includes *inter alia* identifying operational metrics for the industry and assembling and assessing impacts of solutions on the operational metrics for the industry. Stated otherwise, clearly, there may exist elements and/or factors *outside* the bounds of the present invention that may also affect the business value of a company. However, even in light of these external factors, the improvement in the factors addressed by this invention will still prove to improve the business value. Accordingly, Applicant requests withdrawal of the rejection.

Further, claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. §101 being that the claimed invention is allegedly directed to non-statutory matter. In response, Applicant respectfully disagrees with allegations and statements made by the Office regarding the rejection and the Office’s allegation of lack of utility. Applicant contends that the claimed includes invention, *inter alia*, methods, systems, and program products that have a well established utility (i.e., identifying a solution to improve a business value of a company in an industry) that a person of ordinary skill in the art would immediately appreciate. Accordingly, Applicant requests withdrawal of the rejection.

In the Office Action, claims 1-4, 6-8, and 11-22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Machin *et al.* (U.S. Patent No. 6,877,034), hereinafter “Machin”, in view of Sanders (U.S. Patent 6,411,936), hereinafter “Sanders”.

Regarding claim 1, Applicant respectfully requests withdrawal of the rejection because neither Machin nor Sanders teach, or suggest, each and every feature in claim 1, as amended (see

also claims 6, 10, 11, 15, 18 and 22). Further, the invention claimed invention is not obvious in view of Machin and Sanders.

Interpreting Machin and Sanders only for the purposes of this response, Applicant submits that, to the contrary, Machin does not teach or suggest any type of method that includes “**assessing** impacts of the solutions on the operational metrics **for the industry**; **after assessing**, **then comparing** a current operational performance of the company” (emphasis added), as in claim 1 of the present invention. To the contrary, Machin teaches and discloses, via its “gap versus solution optimizer report”, a method that employs a “summary of potential solutions available on the market for narrowing or eliminating that **gap**” (emphasis added). Col. 12, lines 17-21. Clearly, as Figure 14 shows, the suggested solutions and their various impacts (e.g., ROI, GapImpact, risk, etc.) are all in relation to how they may/may not effect the gap *in a specific company* and *not* first assessing impacts of solution on the metrics **for the industry**, as in the present invention (emphasis added). In fact, Machin is completely devoid of even a suggestion of first assessing the various impacts on operational metrics for an entire industry, as with the present invention, and then making any sort of comparison analysis. The Office agrees with the above statements regarding the lack of certain claimed elements in Machin (i.e., “assembling a set of solutions for application by the industry; assessing impacts of application of the solution s on the operational metrics for the industry”). Office Action, page 5, item 8. Further, Sanders does not remedy this glaring deficiency in Machin.

In fact, Sanders entails a system, method, and apparatus for solution for value enhancement of an enterprise. Title. The Office cites column 14, lines 10-65, for support for disclosing this aspect of the present invention. However, a careful reading of the citing section, and Sanders as a whole, indicates that Sanders is applying its invention so as to analyze and

render solutions to a *single “enterprise”*, and not, at first, to an industry as in the present invention. (Emphasis added). “The solution generator then delivers recommended solutions for value enhancement *of the enterprise*, with linkages to specific functions.” Col. 7, lines 35-37. (emphasis added). Clearly, as with Machin, Sanders only applies various methodologies to a single enterprise.

Accordingly, Applicant submits that there is no teaching or suggestion in either Machin or Sanders of any type of a method that first assesses the various solutions and their impacts on operational metrics in an entire industry, and then makes various comparisons and identifications regarding a specific company, as disclosed in claim 1, as amended. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 1.

With respect to dependent claims 2-4, Applicant herein incorporates the arguments presented above with respect to the independent claim from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

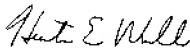
Further, regarding independent claims 6, 10, 11, 15, 18 and 22 and dependent claims 7, 8, 12-14, 16, 17, and 19-21 Applicant contends that for the same reasons stated above, that these claims too are allowable and, accordingly, requests withdrawal of the rejections thereto.

#### IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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